

REMARKS

A. INTRODUCTION

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81, 92-106 are pending and rejected.

Upon entry of this Amendment:

- Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81, 92-106 will be pending
- Claims 1, 56, 60, 69, 71, 75, 81 and 92-95 are the only independent claims

B. SECTION 101 REJECTION

Claims 1, 4, 8, 9, 13, 15-18, 20-23, 28-34, 36, 37, 39-64, 69-71, 75, 81, 96-102 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Each of independent method claims 1, 56, 60, 69, 71, 75 and 81 have been amended to recite determining, via a controller device in electronic communication with at least one customer device (or merchant device, or wireless device). For at least this reason, Applicants submit that every pending method claim is tied to at least one particular apparatus.

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 are rejected because the claimed invention cannot produce a “concrete (i.e repeatable) result,” and the “the result, the awarding of a subsidy, is arbitrary and not concrete” because the recited subsidizer or third party entity “is not given objective definition.” Applicants respectfully traverse the grounds of rejection, which is baseless and has not been supported by substantial evidence made of record. Contrary to what is asserted, in the claims themselves the recited subsidizer or third party entity is clearly and objectively defined by stating that it is not other parties named in the claim. The claims, contrary to what is suggested, do not call for inappropriately subjective analysis. Further, as stated at MPEP § 2106 IV.C.2:

Resolving this question is dependent on the level of skill in the art.

For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field.

The Office Action does not determine or make any finding of the level of skill of the ordinary artisan in that field, and, accordingly, cannot draw conclusions as to whether the ability to determine whether the claims have a result that can be substantially repeatable or substantially produce the same result again.. For at least

the above reasons, Applicants submit that the pending claims are directed to statutory subject matter. Applicants respectfully request the Examiner's reconsideration and withdrawal of the Section 101 rejection.

C. SECTION 112 ¶ 6 REJECTION: MEANS-PLUS-FUNCTION LANGUAGE

The Examiner finds that Claims 93, 95, 104 and 106 do not comply with 35 U.S.C. § 112, sixth paragraph. Applicants neither agree nor disagree with this finding in this paper. Compliance with Section 112(6) is not required for the patentability of any pending claim. Applicants reserve the right to traverse the Examiner's finding in future papers, including on appeal.

D. SECTION 112 ¶ 1 REJECTION: NEW MATTER / LACK OF WRITTEN DESCRIPTION AND SECTION 112 ¶ 2 REJECTION: INDEFINITENESS

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants respectfully traverse the Examiner's Section 112 ¶ 1 rejection of the claims.

Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which we regard as the invention. Applicants respectfully traverse the Examiner's Section 112 ¶ 2 rejection of Claims 1, 4, 8, 9, 13, 15-25, 28-34, 36, 37, 39-64, 69-75, 81 and 92-106, for at least the reasons stated in our prior replies.

Although Applicants do not believe it is necessary for patentability, Applicants have amended the independent claims to remove the language in which a subsidizer or third party is not a direct party to a first transaction.

That a subsidizer or a third party entity may be an entity other than a merchant or restaurant involved in a transaction with a customer, or than such a customer, is clearly described in and apparent to one of ordinary skill in the Specification as originally filed. One of ordinary skill in the art would understand references to third party entity or third party participants in the disclosure as referring to an entity or participant other than the merchant with whom the customer is conducting one transaction, or the customer. In the context of the Specification, use of "third party" would be understood as one other than the principals (e.g., a customer and a merchant) involved in a transaction, such as, e.g., where a tenant might pay rent to a third party, not directly to the landlord. "third party." The American Heritage® Dictionary of the English Language, Fourth Edition. Houghton Mifflin Company, 2004. 25 Aug. 2009. <Dictionary.com <http://dictionary.reference.com/browse/third party>>.

Similarly, the claims define the scope of the recited subject matter with the requisite degree of particularity, and are not unreasonably clear. The Examiner's concerns with respect to "ownership" are overstated. Applicants do not agree with the Examiner's implication that determining whether a given entity is a subsidizer or third party entity would be impossible. Even if, as the Examiner implies, it might be difficult in a given instance to determine whether a particular subsidizer was other than a customer and other than another merchant, for example, the claims are clear that that is the analysis that must be performed, and what the criteria are. That such analysis might even be difficult (which Applicants do not believe), as the Examiner contends, is not fatal to patentability. As to whether an entity may qualify as a subsidizer per the claims one day, and not qualify as a subsidizer the next, is irrelevant; the claim clearly requires a subsidizer, so the absence of any such entity when the claimed embodiments were made, used or sold would be fatal to the Examiner's hypothetical patent infringement lawsuit.

Applicants respectfully traverse the Examiner's contention that "direct party" is not described in the Specification. Though the exact term may not be used, that is not required. The Specification clearly describes different parties participating directly in various types of transactions, and in particular a customer participating in a transaction with a merchant, in which both would be considered by one of ordinary skill in the art to be principals or direct parties to the transaction.

Contrary to what is asserted, the claims do not make reference to an "object" that is variable—the subsidizer or third party entity is clearly defined, in the claims themselves, by what it is not. One of the cases cited in MPEP § 2173.05(b) referred to a rider of unspecified build, which allowed no basis for determining how the parts of a bicycle were related. In contrast, the pending claims provide the standard: a subsidizer or third party entity is not one or more other recited entities. In another case cited in the MPEP section, the court allowed the phrase "so dimensioned" because it was as accurate as the subject matter permitted, further noting that the patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims. Although Applicants do not believe the terms are unclear at all, Applicants submit that the terms subsidizer and third party are at least as accurate as the subject matter permits, and Applicants cannot be required to list in the application all of the possible types of corporate structures that concern the Examiner, much less list them in the claims.

Applicants submit that those of ordinary skill in the art will readily be able to ascertain the bounds of the claimed subject matter, and that all of the pending claims are fully in compliance with the requirements of Section 112(2).

For at least reason, Applicants submit that all of the pending claims comply with Section 112, first paragraph and second paragraph, the claims do not recite any matter new to the Specification and are not unreasonably unclear.

E. SECTION 102(E) REJECTION AND SECTION 103(A) REJECTIONS

Claims 1, 4, 8, 9, 13, 15-18, 20-23, 28-34, 36, 37, 39-64, 69-71, 75, 81 and 92-106 stand rejected under 35 U.S.C. 102(e) as being anticipated by Chen (U.S. Patent No. 6,741,969). We respectfully traverse the Examiner's Section 102(e) rejection.

Claims 19, 24, 25 and 72-74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Chen. We respectfully traverse the Examiner's Section 103(a) rejection.

All of the Examiner's Section 102(e) and 103(a) rejections suffer from clear error and are not supported by substantial evidence made of record. The Examiner has not made the requisite findings that Chen teaches or suggests all of the claimed subject matter of any pending claim, and effectively admits that the prior art was not even considered with respect to features directed to:

the qualifying action concerns a purchase of a product of the subsidizer in a second transaction that is not the first transaction

as generally recited in independent Claims 1, 56, 60 and 92-95

the qualifying action concerns a purchase of a product of the third party entity in a second transaction that is not the first transaction

as generally recited in independent Claim 69, 71, 75 and 81

wherein the at least one merchant is a restaurant, and the subsidizer comprises at least one of an automobile dealership, a mortgage brokerage company, an investment company, an insurance company, a taxi service, a retailer, a department store, a magazine subscription company, a credit card provider, a telephone service provider or an internet service provider

as generally recited in dependent Claims 96-106.

The Office Action refers to MPEP § 2106.01 Computer-Related Nonstatutory Subject Matter as a basis for determining the recited subject matter "was not given patentable weight." Applicants submit that at best MPEP § 2106.01 is directed to examination of claimed subject matter as a whole, and per se claiming of descriptive material. Applicants' claims, however, are not claimed as descriptive material per se; the Examiner does not assert otherwise. Nor are Applicants claiming only "nonfunctional descriptive material...recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal,"

which would not be statutory. Applicants are clearly claiming various methods, articles of manufacture, and apparatus, and not “agreements” per se.

Further, MPEP § 2106.01 suggests the selective elimination of claimed limitations employed by the Examiner, but only with respect to “printed matter.” The Examiner has not made a finding that the above features are “printed matter”; accordingly, the Examiner’s reliance on MPEP § 2106.01 is in appropriate. In summary, MPEP § 2106.01 provides no procedural basis or authority for the Examiner’s assertion that the specified features have no patentable weight.

Accordingly, the Office Action fails to follow the Graham requirements and does not establish a *prima facie* case of anticipation or obviousness of any of the pending claims. Applicants respectfully request the Examiner’s reconsideration and withdrawal of the Section 102(a) and Section 103(a) rejections.

F. ADDITIONAL COMMENTS

Our silence with respect to the Examiner’s other various assertions not explicitly addressed in this paper, including assertions of what the cited reference(s) teach or suggest, the Examiner’s interpretation of claimed subject matter or the Specification, or the propriety of any asserted combination(s) of teachings, is not to be understood as agreement with the Examiner. As the Examiner has not established an unrefutable *prima facie* case for rejecting any of the claims as pending, for at least the reasons stated in this paper, we need not address all of the Examiner’s assertions at this time. Also, the absence of arguments for patentability other than those presented in this paper should not be construed as either a disclaimer of such arguments or as an indication that such arguments are not believed to be meritorious.

G. PETITION FOR EXTENSION OF TIME TO RESPOND & AUTHORIZATION TO CHARGE APPROPRIATE FEES

Applicants understand that a three-month extension of time to respond to the Office Action is necessary.

Please grant a petition for any extension of time required to make this Response timely. Please also charge any other appropriate fees set forth in 37 C.F.R. §§ 1.16 – 1.18 for this paper and for any accompanying papers to:

Charge: \$1110.00

Deposit Account: 50-0271

Order No.: 00-101

Please credit any overpayment to the same account.

H. CONCLUSION

It is submitted that all of the claims are in condition for allowance. The Examiner's consideration is respectfully requested.

If the Examiner has any questions regarding this paper or the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Respectfully submitted,

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Date

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